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OFFICE OF PETITIONS

In re Application of
Masaaki Asonuma
Application No. 10/697,249
Filed: October 31, 2003
Attorney Docket No. SHO-0023
Title: GAMING MACHINE

DECISION REFUSING STATUS
UNDER 37 C.F.R. § 1.47(b)

This is a decision on the "PETITION UNDER 37 C.F.R. §1.47 TO ACCEPT DECLARATION WHEN INVENTOR REFUSES TO JOIN IN APPLICATION," filed October 1, 2004.

The petition is **DISMISSED**.

Rule 47 applicant is given **TWO MONTHS** from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 C.F.R. §1.47(b)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 C.F.R. §1.136(a).

The above-identified application was filed on October 31, 2003, without an executed oath or declaration. Accordingly, on August 11, 2004, applicant was mailed a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted (Notice)," requiring *inter alia* an executed oath or declaration, and a surcharge for its late filing.

In response, rule 47(b) applicant filed the instant petition along with a declaration executed by Nobuo Yaegashi on behalf of ARUZE Corp. and on behalf of sole inventor Masaaki Asonuma; and the late surcharge under § 1.16(e). Rule 47 applicant maintains that status under 37 CFR § 1.47(b) is proper because sole inventor Asonuma has refused to join in the application.

§ 1.47(b) provides that:

Whenever all of the inventors refuse to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom an inventor has assigned or agreed in writing to assign the invention, or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent on behalf of and as agent for all the inventors. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage, the fee set forth in § 1.17(h), and the last known address of all of the inventors. An inventor may subsequently join in the application by filing an oath or declaration complying with § 1.63.

The instant petition does not include an adequate showing that inventor Asonuma has refused to join in the application. Before a refusal can be alleged, applicant must demonstrate that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor. See MPEP 409.03(d). The evidence only supports a conclusion that the combined declaration and power of attorney and assignment papers were sent to inventor Asonuma. A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

Thus, on renewed petition, applicant must establish that the entire application package, including specification, claims and drawings, was presented to non-signing inventor Asonuma and he subsequently refused to sign. If they have not already been sent, a copy of the application papers should be sent to the last known address of the non-signing inventor, or, if the inventor is represented by counsel, to the address of the non-signing inventor's attorney. Documentary evidence, including copies of the transmittal cover letters and return mail receipts, should be made part of the record.

Furthermore, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted. Thus, on renewed petition, a new statutory declaration of Nobuo Yaegashi or other proper party, such as the employee who presents the papers, is required.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (703) 872-9306
 ATTN: NANCY JOHNSON
 SENIOR PETITIONS ATTORNEY

By hand: CUSTOMER SERVICE WINDOW
 2011 South Clark Place
 Crystal Plaza Two Lobby
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Telephone inquiries related to this decision may be directed to the undersigned at (571) 272-3219.

A handwritten signature in black ink, appearing to read "Nancy Johnson", with a long horizontal stroke extending to the right.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions